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09/849,315	05/07/2001	Joseph J. Solon	4025	8680

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EXAMINER

THOMAS, ALEXANDER S

ART UNIT	PAPER NUMBER
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1772

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21

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 21

Application Number: 09/849,315
Filing Date: May 07, 2001
Appellant(s): SOLON, JOSEPH J.

Laurence R. Brown
For Appellant

MAILED
MAY 06 2003
GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 27, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Appellant's brief presents arguments relating to the timeliness of the Final rejection, paper no. 8; this issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

Appellant's brief presents arguments relating to the examiner's failure to consider the Declaration under 37 CFR 1.132 filed after the Final rejection in paper no. 9. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable

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subject matter. See MPEP § 1002 and § 1201. However in order to make the record as complete as possible, the Declaration will be considered in this Examiner's answer.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2, 9-11, 13 and 15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The rejection of claims 1, 14 and 15 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,472,750	MILLER	12-1995
5,834,083	PIGNATARO	11-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 9-11, 13-15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Pignataro. Miller discloses a process of storing and handling batches of rubber strips salvaged from discarded tire carcasses comprising cutting reclaimed tire carcasses into flat storable sections of tire tread strips, placing the

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strips in stacks on pallets wherein the individual tread strips are in frictional contact with adjacent tread strips and transporting the stacked pallets with fork lift trucks for warehousing or storage; see Figure 4, lines 1-6 of the Abstract, column 4, lines 52-64 and column 7, lines 46-63. However Miller does not disclose removing the sidewalls from the tire carcasses before stacking of the resulting strips. Pignataro discloses a process of handling batches of rubber strips salvaged from discarded tire carcasses comprising removing the sidewalls from the tread portions, stacking the tread portions on top of each other, stacking the sidewall portions on top of each other and transporting the tread portions to a recycling facility; see column 1, lines 12-18, column 2, lines 13-18, column 4, lines 3-6 and column 3, lines 59-64. It would have been obvious to one of ordinary skill in the art to remove the sidewalls from the tread portion of the tire carcass in the process of Miller and to stack the sidewalls on the pallets in view of the teachings in Pignataro if extra processing steps and expense could be tolerated and depending on the desired final article that is to be made. Miller also teaches strapping the stacks after they are placed on the pallets; see column 7, lines 50-53. Concerning the interlocking of tread strips on the pallets in a frictional format to resist lateral movement, Miller discloses placing his tread strip in a stacked configuration and strapping the stack into a tight bundle, such a configuration would resist lateral movement of the tread strips and therefore meet the instant claim limitation.

(11) Response to Argument

Concerning appellant's discussion of Miller, the secondary reference is relied upon to show the removal of sidewalls from tire carcasses before transportation to a recycling facility. Appellant further argues that Pignataro does not disclose storing tread strips on pallets or piling the tread strips in rubber to rubber contact. However it is Miller that is relied upon to teach piling tread strips in stacks on pallets for eventual transportation. Pignataro does teach stacking the tread strips in rubber to rubber contact and transporting the stacks; see the Abstract. With respect to the allegation that the rejection proposes a modification of a reference which would render it inoperable, Appellant errs in stating that the proposed prior art rejection requires the sidewalls be exchangeable with the tire tread. No such exchangeability was proposed in the rejection. Regarding appellant's discussion of claim 1, the stacking of tire carcasses on top of each other is taught in both references and would result in rubber to rubber contact of adjacent tread strips. This rubber to rubber contact would result in frictional resistance against movement of the strips lateral to the pallet upon which they are stacked. Concerning appellant discussion of the dependent claims, the above rejection addresses these arguments.

The Declaration filed under 37 CFR 1.132 filed December 9, 2002 is insufficient to overcome the rejection of claims 1, 2, 9-11, 13-15 and 24 based upon Miller in view of Pignataro because it merely set forth opinions of the appellant and fails to set forth objective evidence of nonobviousness. In response to applicant's arguments against the Miller and Pignataro individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

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See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that Pignataro does not teach how to obtain removal of mosquito breeding water cavities from tires stored in the environment, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




ALEXANDER S. THOMAS
PRIMARY EXAMINER

ast
May 5, 2003

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